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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,860	07/21/2003	Claribel Chan	14066-011001 / 2002P00234	6527
32864 7590 05/22/2007 FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER COUGHLAN, PETER D	
			ART UNIT 2129	PAPER NUMBER
			MAIL DATE 05/22/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/624,860

Applicant(s)

CHAN ET AL

Examiner

Peter Coughlan

Art Unit

2129

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/21/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## Detailed Action

1. This office action is in response to an AMENDMENT entered March 21, 2007 for the patent application 10/624860 filed on July 21, 2003.
2. All previous Office Actions are fully incorporated into this Non-Final Office Action by reference.

### ***Status of Claims***

3. Claims 1-3, 5-31 are pending.

### ***35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 5-31 are rejected under 35 U.S.C. 101 for nonstatutory subject matter. The computer system must set forth a practical application of that § 101 judicial

Art Unit: 2129

exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77. The invention is ineligible because it has not been limited to a substantial practical application. Although the claims and the specification recite a business solution management system, both are silent concerning a practical application of said business solution management system. The result has to be a practical application. Please see the interim guidelines for examination of patent applications for patent subject matter eligibility published November 22, 2005 in the official gazette.

In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete." If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. § 101. There are no specified topics in which the business solution management system can be employed. There is no specified field within a topic in which the business solution management system can be employed. Examples of a topic which the claims or specification is silent are, mining operations, retail sales, healthcare. Examples of a field within the topic in which the claims or specification is silent are, human resources, inventory, or profit margin.

The invention must be for a practical application and either:

- 1) specify transforming (physical thing) or
- 2) have the FINAL RESULT (not the steps) achieve or produce a

Art Unit: 2129

useful (specific, substantial, AND credible),  
concrete (substantially repeatable/ non-unpredictable), AND  
tangible (real world/ non-abstract) result.

A claim that is so broad that it reads on both statutory and non-statutory subject matter, must be amended, and if the specification discloses a practical application but the claim is broader than the disclosure such that it does not require the practical application, then the claim must be amended.

The 'business solution management system' is nothing more than an exercise without a practical application. There must be a result, output or use that is a practical application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21, 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims state a 'solution template' without a defined description. Paragraph 0260 states they are 'objects that represent

Art Unit: 2129

application and technology offerings from SAP' which is not defined. Paragraphs 0300 and 0301 state that 'may' include standard BSM Solution Determination Procedures and they 'may' handle creation of new Solution Determination Procedures. 'Solution template' is not defined within the specification.

These claims need to be amended or withdrawn from consideration.

Claims 1, 3, 7, 15, 20, 21, 25, 28, 29, 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims state the existence of a 'technology object.' 'Technology object' is not defined within the specification. In paragraph 0053, the specification states 'technology components utilized in the BSM system 101 'may' be implemented as instances of a technology object type. This does not describe the characteristics of a 'technology object', in addition, the word 'may' is in the paragraph 0053 indicating it 'may' be something else as well.

These claims need to be amended or withdrawn from consideration.

Claims 1, 2, 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

Art Unit: 2129

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims state a first and second data repositories, when in fact the abstract of the invention only mention a single data repository.

These claims need to be amended or withdrawn from consideration.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This claim states that a question is displayed to the user, but is not supported by the specification that this occurs.

This claim must be amended or withdrawn from consideration.

Claims 1, 3, 6, 21, 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims state the existence of a 'business object.' 'Business object is not defined within the specification. In paragraph 0053, 'Business components of a solution development effort may be defined as business object.' The word 'may' is within the description, meaning it 'may not' as well.

Art Unit: 2129

In paragraph 0122, 'the BSM system 150 may provide pre-loaded business object for modeling' is stated. 'May' is used again in addition BSM system provides no additional information concerning what is a 'business object.'

These claims need to be amended or withdrawn from consideration.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This claim states that a user can 'select' a 'business solution' but this is not supported within the specification.

This claim must be amended or withdrawn from consideration.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This claim states that the user can maintain and modify the knowledge base but the specification states that the user can only maintain the knowledge base and not modify it.

This claim must be amended or withdrawn from consideration.



Art Unit: 2129

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Paragraph 0544 states that a user can modify a project template (not a project as stated within the claim) but cannot maintain a project.

This claim must be amended or withdrawn from consideration.

Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no mention within the specification that a user can both maintain and modify an 'integrated implementation.'

This claim must be amended or withdrawn from consideration.

Claims 2, 8, 10, 11, 12, 13, 14, 16, 17, 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims state the existence of a 'repository layer' which is not mentioned within the specification.

These claims need to be amended or withdrawn from consideration.

Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This claim states the existence of a 'technology component identifier'. A 'technology component identifier' is not defined within the specification. It 'may' be in paragraph 0080, '(TCI) application 240 may be a classification system that supports multi-level class definitions' or in paragraph 0081 it 'may be invoked by the Solution Management application 230 to identify a particular class object', but there is no definite purpose of function stated within the specification.

This claim must be amended or withdrawn from consideration.

Claims 17, 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no mention within the specification that the 'solution determination structures' are stored within a repository.

These claims must be amended or withdrawn from consideration.

Art Unit: 2129

Claims 18, 20, 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims use the term 'linked' but there is no mention how a 'link' is made. There is no algorithm mentioned, tables used or method stated which can be used to 'link' objects to routines.

This claim must be amended or withdrawn from consideration.

Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no mention within the specification that a 'plurality of solution determination structures' are provided.

This claim must be amended or withdrawn from consideration.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 29 is rejected under 35 U.S.C. 102(b) (hereinafter referred to as **Fowler**) being anticipated by 'UML Distilled: A Brief guide to the standard Object Modeling Language.'

#### Claim 29

Fowler teaches prompting a user to select at least one instantiated business process object and one instantiated technology object; (**Fowler**, #18, #5; One example of the generation of a 'feature' is the combination of a 'behavioral feature' and a 'structure feature' of Fowler. To add features, the creation of a subtype is needed. Thus 'prompting a user to select...' is the ability to create a 'subtype' of Fowler.) receiving user parameters(**Fowler**, #5, Figure 1.1, #12; 'User parameters' of applicant is equivalent to 'parameter' of Fowler.); designing a business solution using the selected business process object, technology object, and user parameters(**Fowler**, #5, Figure 1.1, #12; 'Predefined business objects' of applicant is equivalent to the 'behavioral feature' of Fowler. 'Technology objects' of applicant is equivalent to 'Structure feature' of Fowler.); and maintaining and modifying the business solution subsequent to implementation of the business solution, the implementation based, at least in Dart, on a current state of the business object and the technology object. (**Fowler**, #8; 'Maintaining' of applicant is equivalent to '...as these objects that are set up and then left alone...' of Fowler. 'Modifying' of applicant is equivalent to '...they are not modified often, and when they are, we can create them again.' of Fowler.)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler as set forth above, in view of Chappel. (U. S. Patent Publication 20020174005, referred to as **Chappel**)

**Claim 1**

Fowler teaches software stored in a computer readable medium (**Fowler, #7**; 'Software' of applicant is equivalent to 'Unified modeling language' of Fowler.), the software allowing a user to (a) design a business solution with user parameters, instantiated user-selectable, pre-defined business objects, and instantiated user-selectable, pre-defined technology objects (**Fowler, #5, Figure 1.1, #12**; 'Predefined

Art Unit: 2129

business objects' of applicant is equivalent to the 'behavioral feature' of Fowler.

'Technology objects' of applicant is equivalent to 'Structure feature' of Fowler. "User parameters' of applicant is equivalent to 'parameter' of Fowler.) and (b) maintain and modify the business solution designed by the user subsequent to implementation of the business solution, the implementation based, at least in part, on a current state of the business objects and the technology objects. (**Fowler, #8**; 'Maintain' of applicant is equivalent to '...as these objects that are set up and then left alone...' of Fowler.

'Modify' of applicant is equivalent to '...they are not modified often, and when they are, we can create them again.' of Fowler.)

Fowler does not teach a first data repository comprising the instantiated user-selectable, pre-defined business objects; and a second data repository comprising the instantiated user-selectable, pre-defined technology objects.

Chappel teaches a first data repository comprising the instantiated user-selectable, pre-defined business objects (**Chappel, ¶0026**; 'First data repository' of applicant is equivalent to 'source database' of Chappel.); and a second data repository comprising the instantiated user-selectable, pre-defined technology objects. (**Chappel, ¶0026**; 'Second data repository' of applicant is equivalent to 'rules database' of Chappel.) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Fowler by using separate databases which contain different types of information as taught by Chappel to have a first data repository comprising the instantiated user-selectable, pre-defined business

Art Unit: 2129

objects; and a second data repository comprising the instantiated user-selectable, pre-defined technology objects.

For the purpose of keeping the information in a modular form to easily adapt to new situations of modifications.

#### Claim 25

Fowler teaches providing at least a first software application and a second software application, the first software application allowing a user to design a business solution with user parameters, instantiated user-selectable, pre-defined business process objects and instantiated user-selectable, pre-defined technology objects(Fowler, #5, Figure 1.1, #12; 'Predefined business objects' of applicant is equivalent to the 'behavioral feature' of Fowler. 'Predefined technology objects' of applicant is equivalent to 'Structure feature' of Fowler. "User parameters' of applicant is equivalent to 'parameter' of Fowler.), and the second software application allowing the user to maintain and modify the business solution subsequent to implementation of the business solution, the implementation based, at least in part, on a current state of the business process objects and the technology objects. (Fowler, #8; 'Maintain' of applicant is equivalent to '...as these objects that are set up and then left alone...' of Fowler. 'Modify' of applicant is equivalent to '...they are not modified often, and when they are, we can create them again.' of Folwer.)

Fowler does not teach providing a first data repository comprising the instantiated user-selectable, pre-defined business process objects; and providing a

Art Unit: 2129

second data repository comprising the instantiated user-selectable, pre-defined technology objects.

Chappel teaches providing a first data repository comprising the instantiated user-selectable, pre-defined business process objects(**Chappel**, ¶0026; 'First data repository' of applicant is equivalent to 'source database' of Chappel.); and providing a second data repository comprising the instantiated user-selectable, pre-defined technology objects. (**Chappel**, ¶0026; 'Second data repository' of applicant is equivalent to 'rules database' of Chappel.) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Fowler by using separate databases for different types of information as taught by providing a first data repository comprising the instantiated user-selectable, pre-defined business process objects; and providing a second data repository comprising the instantiated user-selectable, pre-defined technology objects.

For the purpose of keeping the information in a modular form to easily adapt to new situations of modifications.

### ***Response to Arguments***

5. Applicant's arguments filed on March 21, 2007 for claims 1-3, 5-31 have been fully considered but are not persuasive.



Art Unit: 2129

6. In reference to the Applicant's argument:

### Section 101 Rejections

The Advisory Action appears to maintain the rejection of Claims 1-31 under 35 U.S.C. § 101 as being directed to unpatentable subject matter. See Advisory Action at 2, ¶ 1. Applicants explicitly traverse this rejection, believe that the previously pending claims were patentable as they stood, and hereby reassert the previous comments on such rejections.

Moreover, the patent laws define patentable subject matter as "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto." See 35 U.S.C. § 101. When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete and tangible result. This then satisfies the requirements of 35 U.S.C. § 101. See *In re Alappat*, 33 F.3d 1526, 1543, 31 U.S.P.Q. 2d 1545, 1558 (Fed. Cir. 1994); see also *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 U.S.P.Q. 2d 1596, 1601-02 (Fed. Cir. 1998); [www.uspto.gov/web/menulpbmethod/trangmaterials.ppt](http://www.uspto.gov/web/menulpbmethod/trangmaterials.ppt). While an abstract idea by itself may not satisfy the requirements of 35 U.S.C. § 101, an abstract idea when practically applied to produce a useful, concrete, and tangible result satisfies 35 U.S.C. § 101. See *AT&T Corp. v. Excel Comm. Inc.*, 172 F.3d 1352, 1357, 50 U.S.P.Q. 1447, 1452 (Fed. Cir. 1999) (stating that as technology progressed, the C.C.P.A. overturned some of the earlier limiting principles regarding § 101 and announced more expansive principles formulated with computer technology in mind); see also *In re Musgrave*, 431 F.2d 882, 167 U.S.P.Q. 280 (C.C.P.A. 1970) (cited by the Federal Circuit in *AT&T Corp.*, 172 F.3d at 1356). Thus, producing a useful, concrete, and tangible result is the key to patentability according to State Street and other applicable case law.

Claim 1 recites "[a] business solution management system comprising: software stored in a computer readable medium." Claim 25 recites "[a] computer-implemented method comprising: providing at least a first software application and a second software application." Claim 29 recites "[a]n article comprising a machine-readable medium storing instructions operable to cause one or more machines to perform operations." "Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. § 101." (M.P.E.P. § 2106). Indeed, a method or process remains statutory even if some or all of the steps therein can be performed in the human mind, with the aid of the human mind, or because it may be necessary for one performing the method or process to think. See *In re Musgrave*, 431 F.2d at 893, 167 U.S.P.Q. at 289. In short, the present claims produce a useful, concrete, and tangible result. As such, Applicants respectfully request the Examiner's rejection of Claim 1-31 under 35 U.S.C. § 101 be withdrawn.

Art Unit: 2129

Regardless, Applicants have amended the claims to further advance prosecution of the pending application. For example, Claim 1, as amended, recites "software allowing a user to maintain and modify the business solution designed by the user subsequent to implementation of the business solution, the implementation based, at least in part, on a current state of the business objects and the technology objects." Claims 25 and 29, as presently amended, include certain aspects analogous to amended Claim 1. Therefore, Applicants respectfully request that this rejection be withdrawn.

Examiner's response:

The phrase 'business solution' is an abstract concept. The claims and specification are silent concerning a practical application for the invention. There needs to be a result, which can be used in the real world environment to be statutory. Office Action stands.

7. In reference to the Applicant's argument:

#### Section 102 Resections

The Advisory Action rejected Claims 1-31 under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,339,832 to Bowman-Amuah ("Bowman"). Applicants maintain the traversals and reassert the previous responses to this reference in the prior Office Action at least with respect to the remaining claims.

Moreover, Applicants respectfully assert that Bowman fails to teach, suggest, or disclose certain aspects of the present claims. For example, amended Claim 1 recites inter alia "a business solution with user parameters, instantiated user-selectable, pre-defined business objects, and instantiated user-selectable, pre-defined technology objects." With such aspects now in mind, the Advisory Action previously suggested that the "classes" disclosed in Bowman are equivalent to technology objects (see Advisory Action at 2, ¶¶ 1 and 3); but Bowman--in direct contrast--teaches that classes are distinct from objects. Specifically, Bowman, in its description, teaches that, "it is worthwhile to differentiate between an object and a class of objects at this point. An object is a single instance of the class of objects, which is often just called a class. A class of objects can be viewed as a blueprint, from which many objects can be formed." Bowman, 11:11-15 (emphasis added). In other words, Bowman explicitly teaches that

Art Unit: 2129

an instantiated object (i.e., an instance of a class of objects) is a result of processing on the class and, therefore, is distinct from the class itself. Therefore, classes, as disclosed in Bowman and asserted in the previous action, cannot be the equivalent of "instantiated user-selectable, pre-defined technology objects" as recited in example Claim 1.

Accordingly, Applicants respectfully submit that Bowman fails to teach, suggest, or disclose each and every element of Claim 1, as amended. Claims 25 and 29, as presently amended, include certain aspects analogous to amended Claim 1, discussed above. Therefore, Applicants respectfully request consideration and allowance of amended Claims 1, 25, and 29 and all claims depending therefrom.

Examiner's response:

Bowman is no longer used as a reference for this application. The field of 'Unified Modeling Language' is used as a reference due to the fact the claim terms are abstract terms. Office Action stands.

### ***Examination Considerations***

8. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has the full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the

Art Unit: 2129

art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

9. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior art but link to prior art that one of ordinary skill in the art would find inherently appropriate.

10. Examiner's Opinion: Paragraphs 8 and 9 apply. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

### ***Conclusion***

11. The prior art of record and not relied upon is considered pertinent to the applicant's disclosure.

- 'Design Patterns': Gamma
- 'Object Solutions': Booch
- 'Exploring Requirements: Quality Before Design': Gause
- 'The Unified Modeling Language User Guide': Booch

Art Unit: 2129

- 'UML Toolkit': Eriksson

- 'Visual modeling with Rational Rose 2002 and UML': Quatrani

- 'Applying UML and Patterns: An Introduction to Object Oriented Analysis and Design and the Unified Process, 2<sup>nd</sup> edition': Larman

12. Claims 1-3, 5-31 are rejected.

### ***Correspondence Information***

13. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner Peter Coughlan, whose telephone number is (571) 272-5990. The Examiner can be reached on Monday through Friday from 7:15 a.m. to 3:45 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor David Vincent can be reached at (571) 272-3080. Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,  
Washington, D. C. 20231;

Art Unit: 2129

Hand delivered to:

Receptionist,

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Randolph Building,

401 Dulany Street,

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or faxed to:


(571) 272-3150 (for formal communications intended for entry.)

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5/11/2007



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